UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
033,234	04/25/79	Valentino J. Stella et al.	NHS Rx52A

Norman H. Stepno
Burns, Doane, Swecker & Mathis
George Mason Building
Washington & Prince Streets
Alexandris, Va. 22313

EXAMINER	
N. Trousof	
ART UNIT	PAPER NUMBER
121	4

MAILED
DATE MAILED: SEP 6 1979

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

GROUP 120

☒ This application has been examined. ☒ Responsive to communication filed on June 14, 1979 (April 25, 1979) ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~XXXXXXXX~~ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited, Form PTO-892.
2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152.
4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
   filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

PTO-1142 (10-78)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NUMBER 033,234 | GROUP ART UNIT 121

PART III

NOTIFICATION OF REJECTION(S) AND/OR OBJECTION(S) (35 USC 132)

	CLAIMS (1)	REASONS FOR REJECTION (2)	REFERENCES * (3)	INFORMATION IDENTIFICATION AND COMMENTS (4)
1	1	double patenting	C	the claim encompasses subject matter already patented in the parent application - 4,163,058.
2	1	improper Markush claim		the claim improperly combines very diverse groups representing independent & patentably distinct concepts the combination of which in one claim is not proper - furthermore one skilled in the art would not treat such diverse groups as equivalents-with respect to the various groups note the restriction requirement in the parent - see PARAGRAPH 5 below.
3	1	35 USC 112,par. 2	-	claim indefinite & ambiguous with respect to the use of C_6H_5- since it may have different meanings - suggest the use of a preamble such as "a diphenylhydantoin of the formula"
4	1	35 USC 112,par. 1; 101	-	encompasses inoperative embodiments & subject matter beyond the scope of the enablement - question whether compounds with all of the diverse groups of the claim can be used for the same purpose or in the same manner - note also the aspect of the claim involving "heterocyclic ring" & the like.

5 The restriction requirement set forth in the Office Action of February 23, 1978 (Paper No. 3) in the parent application Serial No. 790,087, filed April 22, 1977 is incorporated herein by reference. In response to an election of species (telephonic) the following concept was elected on August 21, 1979: one of the R groups as $-CHR_1XP(=O)(OH)_2$ with the other R group being the same or hydrogen wherein X is O or S and R_1 is hydrogen or C_1-C_7 straight or branched alkyl. A claim limited to this concept should be presented.

6 Claim 1 is rejected as being obvious over L & M considered together under 35 USC 103. The references considered together (example 13 of L & the teaching that for the compounds of page 4 of M & their exemplification n may be 1-4 suggesting that the noted compound of L may similarly be modified from methylene to ethylene) would clearly suggest the corresponding esters of the claimed compounds. It is believed that the phosphoric acid compounds should be considered to be obvious over their corresponding esters.

10 A & B are cited to further show the state of the art. The Abstract should be shortened but should still give some indication of what R may be.

* Capital letters representing references are identified on accompanying Form PTO-892
The symbol "v" between letters represents - in view of -.
The symbol "+" or "&" between letters represents - and -.
A slash "/" between letters represents the alternative - or -.

NOTE: Sections 100, 101, 102, 103, and 112 of the Patent Statute (Title 35 of the United States Code) are reproduced on the back of this sheet.

EXAMINER N. Trousof | TEL. NO. (703) 557 2517

NATALIE TROUSOF
EXAMINER
GROUP ART UNIT

35 U.S.C. 100. Definitions. When used in this title unless the context otherwise indicates —

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

35 U.S.C. 101. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or cause to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 112. Specification. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.